

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

(Attorney Docket No. 005288.00014)

In re U.S. Patent Application of)	
Senthil SENGODAN)	
)	Art Unit: 2616
Application No. 10/017,398)	
)	Examiner: Mattis, Jason E.
Filed: December 18, 2001)	
)	Confirmation No. 8170
For: Method and Apparatus for Address)	
Allocation in GPRS Networks That)	
Facilitates End-To-End Security)	

PRE-APPEAL BRIEF REQUEST FOR REVIEW**Box Appeal Briefs - Patents**

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-14501

Applicant respectfully requests review of the non-final rejections in the above-identified application. No amendments are being filed with this request. The review is requested for the reasons stated in the below remarks. If any fees are required or if an overpayment is made, the Commissioner is authorized to debit or credit our Deposit Account No. 19-0733, accordingly.

Remarks

Having received and reviewed the Office Action (02-27-08), and since the claims have been twice rejected, Applicant files this pre-appeal brief in accordance with 37 CFR 41.31(a), and respectfully submits that the standing rejections are based on one or more clear errors, and that the appeal process can be avoided through a pre-appeal brief review as set forth in the Official Gazette notice of July 12, 2005.

The specific errors relied upon in this Request for Review include the following:

- The pending 35 U.S.C. §103(a) rejections fail to address all the claim limitations; and
- The Bertrand reference (U.S. Publ. No. 6,687,252), the Takeda reference (U.S. Publication US 2001/0048686 A1), and the alleged Applicant's admitted prior art

(AAPA) fails to disclose the subject matter of the rejected claims 8-14, 28, 31, 32, 35, 36 and 39-51 (sic, 39-44 and 46-51).

- The Bertrand reference (U.S. Publ. No. 6,687,252), the Takeda reference (U.S. Publication US 2001/0048686 A1), and the alleged Applicant's admitted prior art (AAPA) as applied to 1-6, 8-18, 20-26, 28-29, 31-36, and 39, and further in view of Boudreaux (US Patent No. 6,466,556) fail to disclose the subject matter of the rejected claims 37 and 45.

The Office Action Has Not Addressed All Features of Applicant's Claims in the Rejections Under 35 USC §103(a)

Claims 8-14, 28, 31, 32, 35, 36 and 39-51 (sic, 39-44, and 46-51) were rejected under 35 USC §103(a) as being unpatentable over Bertrand reference (U.S. Publ. No. 6,687,252), the Takeda reference (U.S. Publication US 2001/0048686 A1), and the alleged Applicant's admitted prior art (AAPA).

Independent claim 8 substantively recites: "A method comprising: receiving an Activate Packet Data Protocol (PDP) Context Request message at a Serving General Packet Radio System (GPRS) Support Node (SGSN) of a network from a mobile station of the network, the Activate PDP Context Request message having an APN field containing information that explicitly indicates requesting either a private network address or a public network address to be assigned to the mobile station; and sending an Activate PDP Context Accept message to the mobile station containing information assigning one of a private network address and a public network address to the mobile station based on the information contained in the APN field of the Activate PDP Context Request message."

Independent claims 28, 31, 32, 40, 47, 48, and 51 substantively recite features including either an "Activate" or a "Create PDP Context Request message having an APN field containing information that explicitly indicates requesting either a private network address or a public network address to be assigned to a [or "the"] mobile station" of a network.

Regarding independent claims 8, 28, 31, 32, 40, 47, 48, and 51, the Office Action has ignored the words "explicitly indicates requesting either a private network address or a public

network address to be assigned to the mobile station." As recognized in the Office Action, Bertrand et al. does not disclose an Activate PDP Context Request message and a Create PDP Context Request message having an APN field containing information that explicitly indicates requesting one of a private network address and a public network address. As also recognized in the Office Action, Bertrand et al. does not disclose that a public network address or private network address is assigned based on the information contained in an APN field of a Create PDP Context Request message. As recognized in the Office Action, the proposed combination of Bertrand et al. and Takeda et al. does not disclose using destination network information to assign one of a private network address and a public network address to a mobile station.

Bertrand et al. requires a Network Address Translator (NAT) when a Radius server fails to provide an IP address to a mobile terminal using a procedure that calls for a new parameter called a Conditional PDP Address (CPA) parameter being stored in the MT's Home Location Register (HLR) as part of the user subscriber data. According to the Bertrand et al., the CPA parameter indicates whether the subscriber is entitled to a backup IP address in case of failure to obtain one over the Gi interface, and if so, it is also used to determine whether the backup IP address is a private IP address or a public IP address. According to Bertrand et al., if the backup IP address is a private IP address, a NAT is required as part of the GGSN's Gi interface router. See Bertrand et al. at Col. 6, lines 1-20, emphasis added. The pending claims provide methods and apparatus that avoid the requirement of a NAT, and thus avoid the shortcomings associated with a NAT-based approach.

In addition, Takeda et al. does not teach features alleged in the Office Action. More specifically, none of the cited passages in Takeda teach that the node identified in the APN (the address thereof) would explicitly (or implicitly) be equivalent to requesting a private or public network address to be assigned to a mobile station. For example, the Office Action cites to paragraphs 26-27 of Takeda et al., however reading onward, paragraphs 28-29 reveal that the process in Takeda returns to the mobile node **the IP address of the gateway node**, and not an address assigned to the mobile station itself (as recited in the present claims). Similarly are cited paragraphs 71-72 of Takeda et al., and further therein in paragraph 74 Takeda et al. teaches that the GGSN sends its own IP address to the mobile station, not an address assigned to the mobile station by which the mobile station could be reached. Similarly, the cited paragraphs 89-97 and Figure 5 of Takeda et al. fail to teach that either a private network address or a public network

address would be assigned to the mobile station based on information contained in the APN field.

While Takeda et al. discloses at paragraph 94 that if no IP address is allocated to the mobile terminal, an IP address allocation procedure is indicated to the mobile terminal, and that for IP address allocation, the IPv6-compatible DHCP is used for example, there is no indication in Takeda that such IP address allocation involves an APN field containing information that explicitly indicates requesting either a private network address or a public network address to be assigned to the mobile station. As recognized in the Office Action (at page 12), Takeda does not disclose using destination network information to assigned (sic, assign) one of a private network address and a public network address to the mobile station. The proposed combination of Bertrand et al. and Takeda et al., even if proper, does not result in the claimed invention.

It is respectfully submitted that Applicant's specification does not contain any "AAPA" that precludes allowance of the pending claims. That the operation of Realm Specific IP (RSIP) is described in the background of the invention (*see* paragraphs [0007]-[0012], and Fig. 2 of the present application) does not change the fact that at the time of the present invention, the General Packet Radio System (GPRS) standard did not specify whether private or public IP addresses are assigned to a requesting MS, and that standardization is not an issue because at that time a NAT was used a PLMN boundary when private IP addresses were used. *See* paragraph [0013]-[0017] of the present application. The "AAPA" in para. [0008] just discusses the concepts of public and private addresses, and a NAT. It is silent on allocating a private or public address based on an identity of a destination host. If the Office Action was correct, the NAT would not need to be used in para. [0008].

The pending independent claims in the application claim an "APN field containing information that explicitly indicates requesting either a private network address or a public network address to be assigned to [the/a] mobile station." Neither Bertrand et al. or Takeda et al. or alleged AAPA in Applicant's specification, either separately or in combination, teaches or suggests such a feature. Nor does Boudreaux. Neither Bertrand et al., nor Takeda et al., nor alleged AAPA in Applicant's specification provides any independent motivation or suggestion to combine the use of APNs with the assignment of network addresses in the manner claimed by the Applicant. Nor does Boudreaux.

There is no suggestion to combine Bertrand et al., Takeda et al., and alleged AAPA, or that proposed combination with Boudreaux, as advanced in the Office Action, except using

Applicant's invention as a template through a hindsight reconstruction of Applicant's claims. "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rationale underpinning to support the legal conclusion of obviousness." *In re Kahn*, 431 F.3d 977, 988 (Fed. Cir. 2006), cited with approval in *KSR v. Teleflex*, 550 U.S.____, 82 U.S.P.Q.2d 1385, 1396 (2007). The Office Action does not provide articulated reasoning with some rationale underpinning to support the legal conclusion of obviousness.

In sum, the pending independent claims are each patentable over the cited art. The pending dependent claims are patentable over the cited art for at least the same reasons as independent claims from which they depend and for the additional features recited therein. The Applicant respectfully requests reconsideration and withdrawal of the 35 U.S.C. §103(a) rejection.

CONCLUSION

While Applicant believes the above points represent the clearest errors made by the Office, Applicant reserves the right to appeal on other bases and errors should the appeal of this case proceed after the Office's consideration of this paper. All issues having been addressed, Applicant respectfully submits that the instant application is in condition for allowance, and respectfully solicits prompt notification of the same. However, if for any reason the review panel believes the application is not in condition for allowance or there are any questions, the review panel is invited to contact the undersigned at (312) 463-5405.

Respectfully submitted,

Dated: April 9, 2008

By: 

Robert H. Resis
Registration No. 32,168
BANNER & WITCOFF, LTD.
10 South Wacker Drive, Suite 3000
Chicago, IL 60606

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

005288.00014

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

On _____

Signature _____

Typed or printed
name

Application Number

10/017,398

Filed

12/18/2001

First Named Inventor

Senthil Sengodan

Art Unit

2616

Examiner

Mattis, Jason E.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record.
Registration number 32,168

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____



Signature

Robert H. Resis

Typed or printed name

(312) 463-5000

Telephone number

04/09/2008

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.